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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,648	05/14/2001	Amy J. Donnan	DON0002/US/2	8779

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EXAMINER	
SUHOL, DMITRY	
ART UNIT	**PAPER NUMBER**
3712	22

DATE MAILED: 10/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/854,648	DONNAN, AMY J.	
	Examiner	Art Unit	
	Dmitry Suhol	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 October 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4 and 6-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4 and 6-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-9 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 6, the structural features encompassed by the phrase "tear drop-shaped" can't be determined, rendering the claim indefinite.

Regarding claim 7, the structural features encompassed by the phrase "sun-shaped" can't be determined.

Regarding claim 8, the structural features encompassed by the phrase "fire-shaped" can't be determined, rendering the claim indefinite.

Regarding claim 9, the structural features encompassed by the phrase "ghost-shaped" can't be determined, rendering the claim indefinite.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-16 and 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In analyzing claim 1 for patent eligible subject matter, it is useful to first answer the question "What did applicant[s] invent?" In re Abele, 214 USPQ 682 (CCPA 1982). While the preamble of claim 13 characterizes the invention as a "method for exploring emotional experience...", a careful reading of the specification reveals that the applicant's invention can best be described as a kit which having articles which in turn create an environment conducive to the exploration of an emotional experience.

Having determined in general what the invention is, we must analyze it under the prevailing case law. The statute itself allows for the patenting of processes. However, it has been determined in many contexts that not all processes set forth patent eligible subject matter. One test that has recently been applied is whether the invention produces a useful, concrete, tangible result. See e.g., States Street Bank & Trust Co. v. Signature Financial Group Inc., 47 USPQ2d 1596 (Fed. Cir. 1998); AT&T Corp. v. Excel Communications Inc., 50 USPQ2d 1447 (Fed. Cir. 1999). Under that test, the invention must have practical utility, it must produce an assured result, and it must not be merely an abstraction lacking in physical substance.

In this case, the claimed invention does not produce a "concrete" result in the sense that it cannot be reasonably assured that any exploration of an emotional experience will be predictably enabled by the steps set forth. There is simply too much subjectivity involved because the process effectively relies on the state of mind of the participants rather than an objective standard. Actual exploration of an emotional

experience, is completely up to the participants. The process itself is no more than an attempt and a hoped-for result.

The claimed invention does not produce a "tangible" result in the sense that it merely manipulates abstract ideas without producing a physical transformation or conversion of the subject matter expressed in the claim so as to produce a change of character or condition in some physical object. See In re Warmerdam, 31 USPQ2d 1754 (Fed. Cir. 1994); In re Schrader, 30 USPQ2d 1445 (Fed. Cir. 1994). Except for providing a script and positioning a rug, the remaining steps of the claim are effectively no more than items of conversation that are deemed abstract in nature. Mindful of the need to focus on what the inventor did in fact invent, it is not a rug (merely a designated forum) or a script (merely a recorded abstract idea). The method does not produce a physical transformation and yields no tangible result. It is thus effectively a manipulation of abstract ideas and is thus not statutory.

Claims 13-16 and 18 do not produce a useful, concrete, tangible result. The invention as disclosed and claimed does not promote the progress of the useful arts. Accordingly claims 13-16 and 18 do not define statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 4, 6-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Hoose in view of Shaver et al. Van Hoose discloses an interactive toy containing most of the elements of the claims including, providing a plurality of playpieces (fig. 3) as required by claims 1 and 13, each playpiece symbolic of particular emotion (col. 2, lines 35-47) as required by claims 1 and 13, each playpiece comprising a unique shape with respect to the other playpieces (elements 29, 31, 33, 35, 37 and 39) as required by claims 1 and 13, providing a container comprising a storage chamber as required by claims 1 and 13 (element 23 and 45), a first playpiece generally symbolic of love (35) as required by claim 4, a second playpiece generally symbolic of sadness as required by claim 4 (33), a third playpiece generally symbolic of happiness (31) as required by claim 4, a fourth playpiece generally symbolic of fear (29) as required by claim 4, one or more playpieces comprising one or more panels enclosing a stuffing material (col. 5, lines 18-21 and fig. 3, element 35), a container being heart shaped and a plush pillow bag as required by claims 11 and 12 (elements 23 and 45). Van Hoose further discloses interacting with a toy as required by claims 13-15 (col. 3, lines 6+). Regarding the shapes required by claims 6-9, it is considered that the shapes of the play-pieces, 29, 31, 33, 35, 37 and 39, read on all the shapes required (as best understood). Furthermore, the specific shapes encompassed by claims 6-9 are an obvious design choice in that the applicant discloses no critical need or advantage for them.

Although Van Hoose discloses most of the elements of the claims, as stated above, including each playpiece having a color (col. 2, lines 36-47) the reference fails to

teach each playpiece comprising a unique color as required by claims 1 and 13, each playpiece comprising a unique facial expression comprising eyes and mouth as required by claims 1 and 13, a separate playpiece generally symbolic of anger as required by claim 4, and naming an emotion corresponding to a playpiece as required by claim 16. However, Shaver discloses an interactive toy like that of Van Hoose, which teaches the use of a unique color for a plurality of playpieces generally symbolic of a particular emotion (col. 4, lines 58-59 and figs. 10a-10g) as well as a unique facial expression for demonstrating a particular emotion (col. 4, lines 43-46 and figs. 9a-9j). Shaver further teaches that it is know to have user name the emotion corresponding to a playpiece, as required by claim 16, in col. 5, lines 28-37. Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to incorporate the teachings of Shaver in the toy of Van Hoose for the purpose of further assisting children with recognizing emotions, thoughts and actions in daily life by providing playpieces which are distinctive in appearance from each other. It would have been further obvious to provide the toy of Van Hoose with a separate playpiece generally symbolic of anger, especially since Van Hoose recognizes anger as an emotion which needs to be displayed (col. 2, line 39) and since representation of anger as an emotion is well known in the art. It would have been further obvious to including the step of naming an emotion corresponding to a playpiece for the purpose of clearly identifying a child's emotions.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Hoose in view of Shaver et al (as stated above) and further in view of

Childswork/Childsplay "Feelings Frogs Game". Van Hoose discloses most of the elements of the claims, as stated above, but for each playpiece comprising textual information indicative of a particular emotion corresponding to a playpiece as required by claims 17-18. However, Childswork/Childsplay discloses interactive playpieces which teach the use of a unique color and the use of textual information for a plurality of playpieces generally symbolic of a particular emotion (see Childswork/Childsplay "Feelings Frogs Game", page 22). Therefore it would have been obvious to incorporate the teachings of Childswork/Childsplay in the toy of Van Hoose for the purpose of further assisting children with recognizing emotions, thoughts and actions in daily life by providing playpieces which are distinctive in appearance from each other.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ds

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
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